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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,130	08/22/2003	Gregg W. Frey	2003P09222US	8859

7590 06/15/2006

Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/646,130	<b>Applicant(s)</b> FREY ET AL.	
	<b>Examiner</b> Donald Loney	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/13/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 22, 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Aime (6467138) as presented in the last office action, mailed December 22, 2005.

Aime discloses a matching layer 20 containing a plurality of conductive elements 22 therein that extend from the top to the bottom of the layer. The elements can be

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cylindrical. The elements are connected to conductive layers 18,22. At least some of the connection are located toward the edge of the layer. Refer to figures 4, 5a-d, 6a-d,g,f and column 3, lines 28-31, column 4, lines 1-31, column 5, lines 49-64 and column 6, lines 13-39.

4. Claims 1-10, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Corbett et al (6266857) as presented in the last office action, mailed December 22, 2005.

Colbertt et al teaches a matching layer that has holes there through and is then plated with a metal conductor that covers the top and bottom of the layer and also coats the interior of the hole (i.e. a conductor that extends at least partially into the layer). The holes 32 are located more towards the edge of the layer. Refer to figures 4A-4D, 5A-5C in Corbett et al that shows backing layer 24 and metal conductive layer 34 extending through holes 32 along with column 4, line 18 through column 5, line 25.

5. Claims 1-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lum et al (5701901)

Lum et al teaches a matching layer 196 that contains a conductor 212 aligned relative to the top and bottom surface thereof. Refer to figures 20A, 20B, and 21 and 22. The conductors are perpendicular to the top and bottom surfaces as shown in the figures per claims 2, 7 and 9-11. There is more than one conductor per claim 3. The conductors are close to the edge per claim 4, in figures 20A, and 21 and 22. A conductor (i.e. gold electrode layers) is located on both surfaces of the layer (see column 12, lines 60-65).

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6. Claims 13 and 14 are objected to as indicated previously.

***Response to Arguments***

7. Applicant's arguments filed October 10, 2005 and February 8, 2006 have been fully considered but they are not persuasive. In response to applicant's arguments that Both Aime and Colbert et al teach the conductors in the backing layer, not the matching layer, the recitation a matching layer has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The applicant's argument's that the Jepson type format of claim 1 positively recites a matching layer. While true, the claim structure is a layer containing aligned conductors relative to the top and bottom surface at least partially therein, which is shown by the prior art. The preamble does not mention a backing layer in order to distinguish the layers of the invention from the prior art. It also fails to positively recite a transducer. It is the "when used on a sonic transducer" that is intended use and does not structurally distinguish the claimed invention in combination with any other limitations from the prior art (i.e. the backing layer from the matching layer).

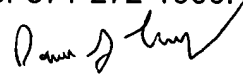
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-

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1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
06/10/06